

Applicant : Thurman R. Reed
Appln. No. : 10/613,174
Page : 7

REMARKS

By way of this amendment, the specification and claim 11 have been amended to correct minor informalities, and claims 1 and 9 have been amended to further recite that the particle containment pad is penetrable by the fastener screw. Claims 15-23 have been withdrawn by the Examiner pursuant to an election/restriction requirement. Accordingly, claims 1-14 remain present in this application. Applicant respectfully requests reconsideration and allowance of the present application.

In the Office Action, the Examiner set forth an election/restriction requirement restricting the invention to group I consisting of claims 1-14 drawn to an electronic package, and group II consisting of claims 15-23 drawn to an assembly method. In particular, the Examiner indicated that the inventions of groups I and II are distinct because the product does not require threaded screws. The Examiner further indicated that Stefan Chmielewski made a provisional election without traverse to prosecute the invention of group I, claims 1-14, during a telephone conference on October 30, 2003.

Applicant affirms the election of claims 1-14; however, Applicant traverses the rejection for the following reasons. In comparing the apparatus and method claims, Applicant submits that none of the independent claims recite threaded grooves and, thus, apparatus claims 1 and 9 are not distinct from method claims 15 and 21 for the reasons stated by the Examiner. Applicant further submits that dependent method claims 18 and 22 recite forming threaded grooves, which are essentially quite similar to dependent apparatus claims 3 and 10 which recite that the screw forms a threaded hole. Accordingly, the inventions of groups I and II are not distinct for the reasons stated by the Examiner, and Applicant respectfully requests that the restriction requirement be withdrawn and that claims 15-23 be reinstated and considered in the present application.

The Examiner rejected claims 9 and 14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner noted that there is

Applicant : Thurman R. Reed
Appln. No. : 10/613,174
Page : 8

insufficient antecedent basis in claim 9. Applicant has amended claim 9 to add "housing," thereby rendering this rejection moot.

Claims 1-3, 6-10, 12, and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by May et al. (U.S. Patent No. 4,568,899). Applicant respectfully traverses this rejection for the following reasons.

Before discussing the rejection, it is important to appreciate Applicant's invention and the advantages realized therefrom. The present invention provides for an electronic package including a housing and electronic circuitry located within the housing. The package includes a first member, a second member, and a hole formed in at least one of the first and second members. A fastener screw engages the hole to fasten the first member to the second member.

This may be achieved with a self-threading screw. The package further includes a particle containment pad disposed adjacent to the hole and penetratable by the fastener screw for collecting particles formed during engagement of the fastener screw within the hole. The particle containment pad collects particles so as to advantageously eliminate or reduce the presence of such particles within an electronic package which could otherwise adversely affect the electrical circuitry.

The reference to May et al. discloses a ground fault accessory (10) connected to a circuit breaker (12) by way of two screws (22 and 24). The screws (22 and 24) are self-tapping screws which tap into available holes in the circuit breaker (12). An insulating washer (26) is placed between the ground fault accessory (10) and the circuit breaker (12). The ground fault accessory (10) has a cover (40) mateable with a base (34), and a printed circuit board (48) is connected to the base and has a circuit thereon. The screws (22 and 24) in May et al. connect the base (34) and cover (40) together and connect them to the circuit breaker (12) as a unit. The circuit board (48) is connected to the base (34) and secured with self-threading screws which are forced into holes in the base.

In contrast, claim 1, as amended, recites an electronic package comprising a housing, electronic circuitry located within the housing, first and second members, and a hole formed in at least one of the first and second members. The package also includes a fastener screw

Applicant : Thurman R. Reed
Appln. No. : 10/613,174
Page : 9

engaging the hole to fasten the first member to the second member. The package further includes a particle containment pad disposed adjacent to the hole and penetrable by the fastener screw for collecting any particles formed during engagement of the fastener screw within the hole. Claim 9, as amended, similarly recites the particle containment pad adjacent to a hole and penetrable by a fastener screw for collecting any particles.

In order to anticipate a claim, the reference must teach each and every claim limitation. In the Office Action, the Examiner stated that May et al. discloses an electronic package having certain features including a particle containment pad disposed adjacent to a hole. In support of this statement, the Examiner indicated that the pad is an unnumbered area around the hole, for example, and cited FIGS. 2, 4, and 5 of May et al. Applicant respectfully submits that the package in May et al. does not disclose any such particle containment pad disposed adjacent to any of the holes, and certainly does not teach or even suggest a particle containment pad penetrable by a fastener screw for collecting particles formed during engagement of the fastener screw within the hole. Instead, screws (22 and 24) extend through holes in the ground fault accessory (10) and circuit breaker (12), and screw (24) further extends through washer (26). No further extension or penetration of screws (22 or 24) are shown or described in May et al. Accordingly, May et al. does not disclose a particle containment pad disposed adjacent to the hole and penetrable by the fastener screw for collecting any particles formed during engagement of the fastener screw within the hole, and thus does not anticipate independent claims 1 and 9.

Accordingly, it is submitted that claims 1-3, 6-10, 12, and 13 are not anticipated by May et al., and Applicant respectfully requests that the rejection of these claims under 35 U.S.C. §102(b) be withdrawn.

The remaining claims 4, 5, 11, and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over May et al. Applicant submits that claims 4, 5, 11, and 14 are likewise allowable for the reasons set forth with respect to independent claims 1 and 9, discussed above.

It is respectfully submitted that May et al. does not teach or suggest a package having a particle containment pad disposed adjacent to the hole and penetrable by the fastener screw for

Applicant : Thurman R. Reed
Appln. No. : 10/613,174
Page : 10

collecting any particles formed during engagement of the fastener screw within the hole, as recited in independent claims 1 and 9, discussed above. Accordingly, Applicant likewise respectfully requests that the rejection of claims 4, 5, 11, and 14 under 35 U.S.C. §103(a) be withdrawn.

The remaining prior art made of record in the present Office Action was not applied to the claims, and thus is not discussed herein. Applicant has reviewed the reference to Bienick et al. and agrees with the Examiner that such reference does not teach or suggest the claimed invention.


By way of the foregoing discussion, Applicant has demonstrated that claims 1-14 are not anticipated or rendered obvious in view of the May et al. patent, and claims 1-14 should therefore be allowed, which allowance is respectfully requested. Applicant further has shown that the restriction/election requirement is improper and that withdrawn method claims 15-23 should be reinstated and examined. If the Examiner has any questions regarding patentability of any of the claims, the Examiner is encouraged to contact Applicant's undersigned attorney to discuss the same.

Respectfully submitted,

THURMAN R. REED

By: Price, Heneveld, Cooper,
DeWitt & Litton

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Date


Kevin T. Grzelak
Registration No. 35 169
695 Kenmoor, S.E.
Post Office Box 2567
Grand Rapids, Michigan 49501
(616) 949-9610

KTG/jrb